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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACQUES PERNOT and JEAN-CLAUDE BOINOT

Appeal 2009-012833
Application 10/580,373
Technology Center 3700

Before: JENNIFER D. BAHR, JOHN C. KERINS, and FRED A.
SILVERBERG, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jacques Pernot and Jean-Claude Boinot (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's rejection under 35 U.S.C. § 103(a) of claims 33-42, 45, 46, 54-56, 58-61, and 63 as unpatentable over Uejima (US 5,902,105, iss. May 11, 1999) and Nakanishi (US 5,011,408, iss. Apr. 30, 1991); of claim 44 as unpatentable over Uejima, Nakanishi, and Hutchinson (US 2,263,808, iss. Nov. 25, 1941); of claim 62 as unpatentable over Uejima, Nakanishi, and Grubbs (US 5,575,647, iss. Nov. 19, 1996); and of claim 64 as unpatentable over Uejima, Nakanishi, and Nemetz (US 6,149,430, iss. Nov. 21, 2000). The Examiner indicated that claims 47-53, 57, and 65 would be allowable if rewritten in independent form. Ans. 3. Claims 1-32 and 43 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The claims are directed to a dental handpiece having a body formed from a single piece. Spec. 1. Claim 33, reproduced below, is illustrative of the claimed subject matter.

33. A dental handpiece including mechanical components and comprising a tool-holder assembly for attaching and for rotationally driving a dental instrument about a drive axis, and an assembly for transmitting rotational movement to the tool-holder assembly;

wherein the mechanical components are mounted in interior portions of a body having a head and a handle, wherein the body is formed as a unitary, electrically insulating envelope

including one part which serves as the handle and another part which constitutes the head;

wherein the head includes a first housing having at least one opening dimensioned to permit component parts of the head to be introduced into and assembled within interior portions of the first housing;

wherein the handle includes a second, longitudinal housing having a longitudinal axis, and an opening at an end of the handle opposite to the head which is dimensioned to permit internal component parts of the handle to be introduced into and assembled within interior portions of the second housing, and a lateral opening communicating with the first housing;

wherein electrical current is conducted from a casing associated with the end of the handle opposite to the head, for connection to a drive motor, to the lateral opening communicating with the first housing by internal component parts of the handle; and

wherein the head includes a barrel pinion assembled for rotation about the drive axis, wherein the barrel pinion includes teeth operatively coupled with teeth of an output pinion associated with the internal component parts of the handle, and wherein the barrel pinion is electrically conductive and ensures an electrical connection between the internal component parts of the handle and the dental instrument coupled with the tool-holder assembly.

OPINION

Appellants' independent claim, and thus each of the claims depending therefrom, requires a handpiece comprising "a body having a head and a handle, wherein the body is formed as a unitary, electrically insulating envelope including one part which serves as the handle and another part which constitutes the head" and "wherein electrical current is conducted from a casing associated with the end of the handle opposite to the head, for connection to a drive motor, to the lateral opening communicating with the

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first housing by internal component parts of the handle.” An issue presented in this appeal is whether Uejima and Nakanishi would have rendered obvious such a handpiece. *See* App. Br. 20-21; Reply Br. 7, 8-10.

The Examiner’s rejection relies in part on a finding that Uejima’s shank module 13 and head 14 form an electrically insulated body and head. Ans. 3. This finding is not consistent with Uejima’s disclosure.

Specifically, Uejima discloses that housing 13c of the shank module 13 is made of an electrically conductive material in order to form part of the conduction circuit from terminal 31 to the cutting tool 15. Uejima, col. 5, ll. 44-67; col. 6, ll. 21-24. According to Uejima, the surface of the housing 13c is provided with an insulating film so that, even if the handpiece 11 makes contact with tissue of the patient during root canal length measurement, the measurement circuit is not adversely affected. Uejima, col. 6, ll. 24-26, 39-43. While the film may form an electrically insulating envelope, the electrically conductive housing 13c, and hence the shank module 13 (on which the Examiner reads the claimed electrically insulating “body”), cannot be considered to be a body formed as an electrically insulating envelope, as called for in claim 33. Further, to modify the shank module 13 by making the housing 13c of an electrically insulating material would interrupt the electrical circuit described by Uejima. Thus, even assuming it would have been obvious, in view of the teachings of Nakanishi, to make the shank module 13 and head 14 as a unitary body, this would not result in the claimed invention.

We appreciate that Uejima discloses a second, albeit seemingly less preferred, embodiment in which the conduction circuit is made without passing through the handpiece 11, but instead by passing through an external lead extended along the handpiece 11. Uejima, col. 12, ll. 60-65; fig. 11. In

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such an embodiment, the housing 13c of the shank module would not form part of the electrical circuit, and thus need not be made of electrically conducting material. However, such an embodiment would not satisfy the further limitation in claim 33 “wherein electrical current is conducted from a casing associated with the end of the handle opposite to the head, for connection to a drive motor, to the lateral opening communicating with the first housing by internal component parts of the handle.”

For the reasons discussed above, we conclude that the Examiner has not established a *prima facie* case that the combined teachings of Uejima and Nakanishi would have rendered obvious the subject matter of claim 33, or of its dependent claims. We reverse the rejection of claims 33-42, 45, 46, 54-56, 58-61, and 63 as unpatentable over Uejima and Nakanishi.

In rejecting the remaining dependent claims, the Examiner has not relied on any teaching in Hutchinson, Grubbs, or Nemetz which would make up for the deficiency in the combination of Uejima and Nakanishi discussed above. Thus, we also reverse the rejections of claim 44 as unpatentable over Uejima, Nakanishi, and Hutchinson; of claim 62 as unpatentable over Uejima, Nakanishi, and Grubbs; and of claim 64 as unpatentable over Uejima, Nakanishi, and Nemetz.

DECISION

The Examiner’s decision is reversed.

REVERSED

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